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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/839,082	04/20/2001	David D'Arcy Clifford	T8466709US	2707
26912	7590	03/15/2005	EXAMINER	
GOWLING LAFLEUR HENDERSON LLP			AFTERGUT, JEFF H	
COMMERCE COURT WEST, SUITE 4900			ART UNIT	
TORONTO, ON M5L 1J3			PAPER NUMBER	
CANADA			1733	

DATE MAILED: 03/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/839,082

Applicant(s)

CLIFFORD, DAVID D'ARCY

Examiner

Jeff H. Aftergut

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 February 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1-22 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

In claim 1, lines 18-19, the claim recites "moving a periphery of said stack in a direction toward a center thereof while maintaining a thickness of the stack that is substantially equal to the uniform gap". The original disclosure failed to describe such movement of the periphery of the stack toward the center in the pressing operation. The only description in the disclosure of the pressing operation is found on page 7, line 19- page 8 (the end of the page). There is no mention of the movement of the periphery of the edge of the assembly toward the center of the assembly. Additionally, applicant is advised that the drawings are merely schematic and one cannot derive exact relationships from the same without having expressly stating that the drawings were to scale and that their intent was to provide exact measures of what was transpiring.

As such, while the language relating to "drawing inward" (which is now not present in the claim) was considered new matter and not provided for in the original disclosure, the description of "moving a periphery of said stack in a direction toward a

center thereof" is likewise considered to be new matter as such was not described in such a way to be considered in applicant's possession at the time the application was filed.

Claim Rejections - 35 USC § 103

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. Claims 1-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Clifford or PCT WO 00/48831 and any one of Japanese Patent 11-151530, Japanese Patent 11-347642 or Onat et al optionally further taken with Japanese Patent 58-252216 or Kojima et al for the same reasons as previously presented in paragraph 2 of the Office action dated 11-25-03.

The applicant is advised that in a like manner to applicant, the pressing operation performed by Japanese Patent '530 did not restrain the periphery during the pressing operation. Inasmuch as the pressing operation disclosed by Japanese Patent '530 did not restrain the material on the periphery, it would intrinsically flow that the material at the periphery would be directed toward the center (as conservation of material dictates the material must go somewhere). Additionally, while it is agreed that neither one of PCT '831 or Clifford expressly stated that the laminate was subjected to a compression molding operation in a die press, the applicant is advised that both references did elude to the use of the assemblies as vehicle body parts, see Clifford at column 1, lines 15-18, PCT '831 at page 1, lines 4-7. Those skilled in the art of manufacturing vehicular bodies

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would have understood that the bodies would have been formed by shaping a metal sheet material in a die pressing operation as evidenced by Japanese Patent '530, Japanese Patent '216 or Onat et al. clearly, in the transformation of the assembly into a vehicle body panel one skilled in the art would have readily recognized that the material would have been shaped in a pressing operation.

5. Claims 1-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references as set forth above in paragraph 4 further taken with either one of Hirota et al or Hook et al for the same reasons as expressed in paragraph 7 of the Office action dated 8-3-04.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1-22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, line 15, the language "said uniform pressure" appears which lacks proper antecedent basis. There is no description of uniform pressure applied in the operation. It should be noted that in claim 3, lines 1-2, the language "said uniform pressure" appears which lacks proper antecedent basis as no uniform pressure has been previously defined.

Response to Arguments

8. Applicant's arguments filed 2-3-04 have been fully considered but they are not persuasive.

As an initial matter, the terminal disclaimer filed by applicant has been accepted and the double patenting rejection presented earlier has been overcome as a function of the disclaimer.

Regarding the 112, first paragraph rejection, the applicant is advised that the newly amended claim still has subject matter recited therein which was not in applicant's possession at the time the invention was made. Namely, the "moving a periphery of said stack in a direction toward a center thereof" was never described in the original disclosure. Additionally, applicant is advised that the drawings are merely schematic and were never described as being the exact dimension of the operations.

The applicant argues in the response that what "might" take place in Japanese Patent '530 is not a basis for a rejection. The pressing operation in Japanese Patent '530 to form the vehicle panel was performed in a similar manner to the die pressing of the claims. Namely there was no restraint on the periphery of the metal sheet material therein. As there is no restraint on the periphery of the panel of the disclosure metal laminate used in the die pressing operation, one would have expected that the die pressing operation of Japanese Patent '530 would have acted the same way as that of the disclosed die pressing operation defined in the disclosure. In other words, one skilled in the art would have recognized that if there is no restraining means along the

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edge that the metal laminate must move toward the center as such is intrinsic in the operation.

The applicant argues that the references to Japanese Patent '642 and Onat failed to teach anything regarding the movement of the periphery of the stack, however the applicant is advised that the applicant's own disclosure failed to state that the periphery of the material was moved toward the center in the pressing operation. Additionally, these references were in fact cited to show that in the manufacture of a vehicle body one skilled in the art would have subjected a metal material to a pressing operation to form the same into the desired panel configuration. Japanese Patent 58-252216 or Kojima et al were cited to show that those skilled in the art would have readily understood that the periphery of the panel would have moved toward the center during the pressing operation. The applicant is silent as to the teachings of Japanese Patent 58-252216 or Kojima et al and therefore it is believed that the applicant agrees with the interpretation of the references.

Regarding Hook or Hirota, the applicant argues that these references do not suggest the die press as recited or the specific composite part. The applicant is advised that these references need not teach this, as the references to Clifford or PCT WO 00/48831 suggested the composite laminate and the specific shape of the die press was suggested by the references to any one of Japanese Patent 11-151530, Japanese Patent 11-347642 or Onat et al optionally further taken with Japanese Patent 58-252216 or Kojima et al. the applicant is advised that the references to Hook or Hirota

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were cited to further evidence that the periphery of the panel would have moved inwardly toward the center.

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeff H. Aftergut whose telephone number is 571-272-1212. The examiner can normally be reached on Monday-Friday 7:15-345 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Blaine Copenheaver can be reached on 571-272-1156. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Jeff H. Aftergut
Primary Examiner
Art Unit 1733

JHA
March 13, 2005